

Application No.:09/681,008
Amendment dated: March 22, 2004
Reply to Office Action of November 21, 2003

b.) Remarks

Claims 1, 2, 4-6 and 8-22 are pending in this application. Claim 1 is amended, Claim 9 is canceled. Claim 10 is amended to make it consistent with Claim 1 in view of canceled Claim 9.

Claims 1-2, 4-6 and 8-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,881,045 issued to Inoue and in view of U.S. Patent No. 6,275,454 issued to Boutaghou et al.. This rejection is respectfully traversed for the following reasons.

In response to items 24 and 25 of the Office Action, "Response to Arguments", Applicant amended Claim 1 to more particularly point out that the specimen receiving device is in a confocal microscope by deleting that recitation from the preamble and making it a part of the first claim element. Therefore, the Patent Office's assertion that the recitation "in a confocal microscope" is merely an intended use is now moot.

Also, Claim 1 now incorporates the "carousel insert" from Claim 9 to more particularly point out the distinction between Claim 1 and the device of Inoue. Specifically, "a specimen receiving device for receiving a carousel insert holding a plurality of specimens in a confocal microscope" in Claim 1 is not disclosed or taught or suggested in Inoue. A carousel insert holding a plurality of specimens is not a stack of CD holders as described in Inoue.

Moreover, the reasons for the rejection presented in items 3, 4 and 5 of the Office Action are mutually exclusive and inconsistent. In item 3 the Patent Office wrote that Inoue teaches "a specimen receiving device for hold a plurality of specimens (i.e. CD)". In Inoue there is a magazine holding a stack of CDs. Each CD is placed on its respective cartridge (cartridges 1-6 in Fig. 6) which cartridges form a stack. Further in item 4 of the Office Action the Patent Office writes that the specimen receiving device is "linearly displaceable via transport mechanism). Further in item 5 it is written that the "specimen receiving device being rotatable about the axis of rotation". Presumably, the Patent Office

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analogizes the magazine of Inoue with the specimen receiving device in Claim 1. But if the magazine 50 with a stack of CDs of Inoue is analogized with the specimen receiving device of Claim 1, then it is clear from Figs. 2, 4, 5, 6, and 9 that the magazine 50 itself is not rotatable, it is a selected cartridge with an individual CD that is rotatable on its turntable after being moved from the magazine to the playback position. (Col. 9 line 40 – Col. 10 line 6, Col. 10 lines 32-52). So if the Office asserts that Inoue discloses a specimen receiving device with a plurality of specimens of Claim 1 being rotatable, this is not true, because magazine 50 in Inoue is not rotatable, only an individual cartridge is. The individual cartridge in Inoue also cannot be analogized with the specimen receiving device holding a plurality of specimens of Claim 1, because the cartridge holds only one CD.

Therefore, for the reasons articulated above, the assertion of the Patent Office that Inoue discloses the specimen receiving device for holding a plurality of specimens in a carousel insert is incorrect. The combination of Inoue and Boutaghou does not disclose or teach or suggest the specimen receiving device as claim in Claim 1. Therefore, the rejection should be withdrawn and Claim 1 should be allowed. Claim 2, 4-6, 8 and 10-22 depend off Claim 1 and should also be allowed.

Applicant believes that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. The Examiner is strongly encouraged to contact the undersigned and to discuss allowance of the pending Claims.

Respectfully submitted,

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